



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

07/625,668 12/13/90 WALLACH

D WALLACH-4

EXAMINER

CARLSON, K

ROGER L. BROWDY  
BROWDY & NEIMARK  
419 SEVENTH STREET, NW  
WASHINGTON, DC 20004

18M1

ART UNIT

PAPER NUMBER

1812

DATE MAILED:

03/24/93

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12-22-93 (#16) ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |                                                                                     |                                                                                  |
|-------------------------------------------------------------------------------------|----------------------------------------------------------------------------------|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>                                                      |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-6, 8, 9 are pending in the application.  
Of the above, claims — are withdrawn from consideration.
2. ☒ Claims 7 have been cancelled.
3. ☐ Claims — are allowed.
4. ☒ Claims 1-6, 8, 9 are rejected.
5. ☐ Claims — are objected to.
6. ☐ Claims — are subject to restriction or election requirement.
7. ☒ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on —. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on — has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on —, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. —; filed on —.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Serial Number 07/625668

Art Unit 1812

This Office Action is in response to Paper #16, filed  
December 22, 1992. Claims 1-6, 8, and 9 are pending and Claim 7  
5 has been canceled.

Applicants argue that the priority of the instant  
application should not be set to the filing date of Israel Patent  
095064 of July 12, 1990 but to September 12, 1988 which is the  
10 filing date of the US parent application to this instant  
application, 07/243092. Applicants proceed to point out where in  
'092 they believe that the instant invention is enabled. The  
Examiner disagrees because '092 does not teach the protein  
sequence encoding TBP-1, the corresponding DNA sequence, nor  
15 demonstrate successful transfection of host cells for the  
expression of TBP-1. Indeed, only a portion of the N-terminal  
sequence of TBP-1 is known at the time of the filing of '092.  
Though '092 does offer guidance concerning how to make TBP-1 or  
the DNA encoding TBP-1, it does not teach how to use these  
20 protocols successfully in not one instance. This is the mandate  
of enablement under 35 USC 112, that is, the specification must  
teach how to make and use the invention claimed. It is not  
predictable that TBP-1 would be encoded by a single gene, that  
is, it could be encoded by the gene that encodes the mature

Serial Number 07/625668

Art Unit 1812

protein. Therein the cDNA needed to transfect host cells would not be readily pulled from a Southern, for example. It would require undue experimentation to successfully determine from an N-terminal sequence the entire protein sequence encoding TBP-1, the isolated genomic DNA or cDNA, and if such DNA could be inserted into any expression system and expressed in any cell line such that a functional TBP-1 is recombinantly produced. Therein, the Examiner regrettably disagrees with the Applicants arguments that the invention as presently claimed is enabled in the parent application and maintains that the priority date be set to July 12, 1990.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-9 under 35 USC 112, first paragraph, is withdrawn.

The rejection of Claims 1-9 under 35 USC 112, second paragraph, is withdrawn.

Serial Number 07/625668

Art Unit 1812

The Applicants have made no arguments of the teachings of the references cited in the previous Office Action because of the date of priority issues discussed above. Therein, all rejections are maintained as follows:

5

Claims 1, 2, and 6-8 are rejected under 35 U.S.C. § 102(a) as being anticipated by Loetscher et al. or Schall et al. as discussed in the previous Office Action.

10

Claims 3 and 4 are rejected under 35 U.S.C. § 103 as being unpatentable over Loetscher et al. or Schall et al. in view of Sambrook et al. as discussed in the previous Office Action.

15

Claims 5 and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Loetscher et al. or Schall et al.

20

The Examiner believes that all pertinent issues have been addressed.

Serial Number 07/625668

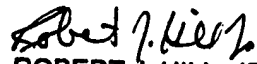
Art Unit 1812

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

5 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL  
ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS  
ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS  
OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION  
IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED  
10 STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE  
ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE  
PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE  
MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE  
STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM  
THE DATE OF THIS FINAL ACTION.

15  
  
Any inquiry concerning this communication or earlier  
communications from the examiner should be directed to Karen  
20 Cochran Carlson, Ph.D. whose telephone number is (703) 308-0034.

Any inquiry of a general nature or relating to the status of  
this application should be directed to the Group receptionist  
whose telephone number is (703) 308-0196.

  
ROBERT J. HILL, JR.  
SUPERVISORY PATENT EXAMINER  
GROUP 1800